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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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06/15/2001

Takeshi Kikuchi

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11/30/2006

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EXAMINER

NGUYEN, PHUOC H

ART UNIT

PAPER NUMBER

2143

DATE MAILED: 11/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/882,721

Applicant(s)

KIKUCHI ET AL.

Examiner

Phuoc H. Nguyen

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2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-9,17-19,21-27,37,39,41-45,65-67,70,72-74 and 115-117 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-9, 17-19, 21-27, 37, 39, 41-45, 65-67, 70, 72-74, 115-117 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This office action is in response to the amendment filed on September 6, 2006. Applicant amended claims 1, 3-9, 17-19, 21-27, 37, 39, 41-45, 65-67, 70, 72-74, 115-117, and cancelled claims 2 and 71. The Amendment filed on September 6, 2006 have been entered and made of record. Therefore, pending claims 1, 3-9, 17-19, 21-27, 37, 39, 41-45, 65-67, 70, 72-74, 115-117 are presented for further consideration and examination.

Response to Arguments

2. Applicant's arguments with respect to claims 1, 18, 19, 37, 65, and 70 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 5, 7-9, 17-19, 23-27, 37, 41, 43-45, 65, 70, 72, 74, and 115-117 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz et al. (Hereafter, Katz) U.S. Patent 5,926,624 in view of Tanaka et al. (Hereafter, Tanaka) U.S. Patent 7,113,927.

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Regarding claims 1, 19, 37, 65, and 70, Katz discloses a content distribution system (Figure 10) which comprises a portable terminal (e.g. playback device, 212), a distribution server (e.g. Library Server, 260) capable of communicating with said portable terminal (e.g. Figure 10, 212 communicates with 260), and a client terminal (e.g. client system 214 or 814) capable of communicating with said distribution server and in which a content item is distributed from said distribution server to said portable terminal by use of said client terminal (e.g. Figure 10; communication between 212, 214, 240, and 260), wherein said distribution server comprises: trial content distribution means for distributing, in response to a request from said client terminal, a trial content item to said client terminal (col. 13 lines 25-58); said client terminal comprises: trial content request means for requesting said distribution server to distribute the trial content item to said client terminal, trial content item receiving means for receiving said trial content item distributed from said distribution server, reproducing means for reproducing said received trial content item, and regular content request means for requesting said distribution server to distribute the regular content item to said portable terminal (col. 8 lines 7-12; and col. 13 lines 19-58); and said portable terminal comprises: regular content item receiving means for receiving said regular content item distributed from said distribution server, and reproducing means for reproducing said received regular content (col. 13 lines 25-58); however, Katz does not clearly disclose regular content distribution means for distributing, in response to a request from client terminal, a regular content item to said portable terminal and charging a fee to a user of said portable terminal, when the regular content item is distributed to said portable terminal.

Tanaka teaches regular content distribution means for distributing, in response to a request from client terminal, a regular content item to said portable terminal and charging a fee

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to a user of said portable terminal, when the content item is distributed to said portable terminal (Figure 2, col. 6 last paragraph through col. 7, 1st paragraph).

It would have been obvious to one of the ordinary skill in the art at the time of the invention was made to incorporate Tanaka's teaching into Katz's method to provide regular content from the distribution server to the portable terminal upon the client terminal request, and charging a fee to a user of said portable terminal in order to prevent data contents from being illegally copied, achieving highly efficient data compression and transmission (e.g. col. 2 lines 1-3).

Regarding claims 5, 23, and 41, Katz further discloses regular content request means of said client terminal comprises portable-terminal-specifying-data transmission means for transmitting to said distribution sever data for specifying said portable terminal, and said regular content distribution means of said distribution server comprises direct distribution means for distributing the regular content item directly to said portable terminal specified by the data transmitted by said portable-terminal-specifying-data transmission means (Figures 2, 8 and 10; col. 13 lines 19-64 and col. 16 last paragraph through col. 17 1st paragraph).

Regarding claims 7, 25, 43, 74 and 115-117, Katz further discloses client terminal comprises type-specifying-data transmission means for transmitting to said distribution server data which specify a type of said reproducing means of said portable terminal, and said regular content distribution means of said distribution server distributes to said portable terminal a regular content item corresponding to the data which specify the type of said reproducing means of said portable terminal (col. 13 lines 19-64).

Regarding claims 8, 26 and 44, Katz further discloses distribution server comprises a database which stores a content item (Figure 2; Digital information files 262); and said regular content distribution means of said distribution server processes the content item stored in said database in accordance with the data which specify the type of said reproducing means of said portable terminal and distributes the processed content item to said portable terminal as the requested regular content item (col. 8 2nd paragraph; and col. 13 lines 19-64).

Regarding claims 9, 27 and 45, Katz further discloses distribution server comprises a database which stores a plurality of content items (Figure 2; Digital information files 262) corresponding to types of said reproducing means of said portable terminal, and said regular content distribution means of said distribution server selects one content item from the plurality of content items stored in said database in accordance with the data which specify the type of said reproducing means of said portable terminal and distributes the selected content item to said portable terminal as the requested regular content item (col. 8 2nd paragraph; and col. 13 lines 19-64).

Regarding claim 17, Katz further discloses a different trial content item is distributed depending on the type of said reproducing means of said portable terminal (col. 13 lines 36-40).

Regarding claim 18, Katz further discloses distribution server comprises charging means charges a predetermined fee as said fee to the user of said portable terminal when the regular content item is distributed, and charges a fee lower than the predetermined fee to the user of said portable terminal when the trial content item is distributed (col. 11 1st paragraph).

Regarding claim 72, Katz further discloses content request processing comprises portable-terminal-specifying-data transmission processing for transmitting to said distribution

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server data for specifying said portable terminal (Figures 2, 8 and 10; col. 13 lines 19-64 and col. 16 last paragraph through col. 17 1st paragraph).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3, 4, 6, 21, 22, 39, 40, 42, 66, 67 and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz in view of Dodd U.S. Patent 6,633,849.

Regarding claims 3, 4, 21, 22, 39, 40, 66 and 73, Katz discloses a content distribution system which comprises a portable terminal, a distribution server capable of communicating with said portable terminal, and a client terminal capable of communicating with said distribution server and in which a content item is distributed from said distribution server to said portable terminal by use of said client terminal; however, Katz fails to teach distribution server comprises: URL mailing means for sending an electronic mail to said portable terminal in order to transmit to said portable terminal a URL of a download page for downloading the regular content item, and download means for distributing the regular content item to said portable terminal, in response to access to the URL, by said portable terminal, and said portable terminal comprises content obtaining means for accessing the URL of the download page transmitted from said distribution server in order to download the regular content item.

Dodd teaches distribution server comprises: URL mailing means for sending an electronic mail to said portable terminal in order to transmit to said portable terminal a URL of a download page for downloading the regular content item, and download means for distributing the regular content item to said portable terminal, in response to access to the URL, by said portable terminal, and said portable terminal comprises content obtaining means for accessing the URL of the download page transmitted from said distribution server in order to download the regular content item; and content request means of said client terminal comprises address transmission means for transmitting to said distribution server a mail address of said portable terminal to which the URL of the download page is to be transmitted by means of an electronic mail (Figure 5; and col. 11 lines 41 through col. 12 lines 13).

It would have been obvious to one of the ordinary skill in the art at the time of the invention was made to incorporate to Dodd's teaching into Katz's method to provide the intended recipient email address and send an URL link to the intended recipient for downloading the content, because by making extensive use of e-mail because it is fast, flexible, and reliable.

Regarding claims 6, 24, 42 and 67, Katz discloses the data transmitted by said portable-terminal-specifying-data transmission means of said client terminal, and direct distribution means of said distribution server transmits the regular content to the portable terminal; however, Katz fails to teach the use of mail address of the portable terminal to transmit the regular content item.

Dodd teaches distribution server use of mail address of the portable terminal to transmit the regular content item (Figure 5).

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It would have been obvious to one of the ordinary skill in the art at the time of the invention was made to incorporate to Dodd's teaching into Katz's method to provide the intended recipient email address and send an URL link to the intended recipient for downloading the regular content, because by making extensive use of e-mail because it is fast, flexible, and reliable.

Conclusion

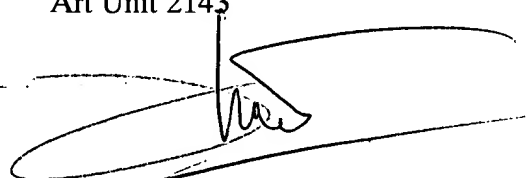
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuoc H. Nguyen whose telephone number is 571-272-3919. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

November 26, 2006

Phuoc H Nguyen
Examiner
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A handwritten signature in black ink, appearing to read 'Phuoc H. Nguyen', is written over a horizontal line. The signature is stylized with a large, sweeping loop on the left and a more compact, cursive-like structure on the right.